

REMARKS

The following claims are pending in the application: 1 – 10

The following claims have been amended: 1

The following claims have been deleted:

The following claims have been added:

As a result of the foregoing Amendment, the following claims remain pending in the application: 1 – 10.

Objections to the Specification

The Examiner requires the cancellation of those portions of the specification related to previously entered (and subsequently canceled) claims 11 through 60. Further, the Examiner requires that the Applicants submit an amendment clarifying the disclosure so as to permit the Examiner to make a proper comparison of the invention with the prior art.

Applicants have submitted herewith a substitute specification (both a clean and a marked-up copy) thereby overcoming the Examiner's outstanding objections.

Rejection under 35 U.S.C. §112, first paragraph

The Examiner has rejected claims 1 – 10 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Applicants have amended claim 1 to more accurately claim the subject matter of the present invention. Applicants respectfully direct the Examiner's attention to U.S. Provisional App. No. 60/275,762 from which the present application claims priority.

Disclosure support for the amendment to claim 1 is found on page 2 of the '275 Provisional App. Accordingly, Applicants respectfully submit that the Examiner's outstanding rejection may be properly withdrawn.

Rejection under 35 U.S.C. §112, second paragraph

The Examiner has rejected claim 1 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants have amended claim 1 to provide antecedent basis for the limitation "Y". Accordingly, Applicants respectfully submit that the Examiner's outstanding rejection may be properly withdrawn.

The Rejection Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1 through 10 under 35 U.S.C. §103(a) as being unpatentable over Yang et al. taking the position that it would have been obvious to one of ordinary skill in the art to replace the aromatic ring of Yang with an aromatic ring containing nitrogen on the ring since said replacement does not effect the mechanism and form the similar product of the claimed repeating unit in the absence of a showing of unexpected results derived from the use.

Applicants respectfully submit that the Examiner's outstanding rejection may be properly withdrawn as the Yang et al. reference fails to provide any motivation or suggestion of making the substitution which the Examiner regards as obvious, even if Yang discloses what the Examiner alleges it to. MPEP 2144.08 A clearly provides that "it

is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teaching.” See e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) (“[T]he mere possibility that one of the esters or the active methylene group-containing compounds … could be modified or replaced such that its use would lead to the specific sulfoalkylated resin recited in claim 8 does not make the process recited in claim 8 obvious ‘unless the prior art suggested the desirability of [such a] modification’ or replacement”). Thus, where the Examiner has failed to cite any prior art suggesting the desirability of replacing the aromatic ring of Yang with an aromatic ring containing nitrogen on the ring, one cannot fairly conclude that the Examiner has established the *prima facie* case of obviousness required to reject the pending claims under 35 U.S.C. §103(a). Accordingly, Applicants respectfully submit that the Examiner’s outstanding rejection may be properly withdrawn.

CONCLUSION

In view of the foregoing amendment and accompanying remarks, the Applicants respectfully submit that the present application is properly in condition for allowance and may be passed to issuance upon payment of the appropriate fees.

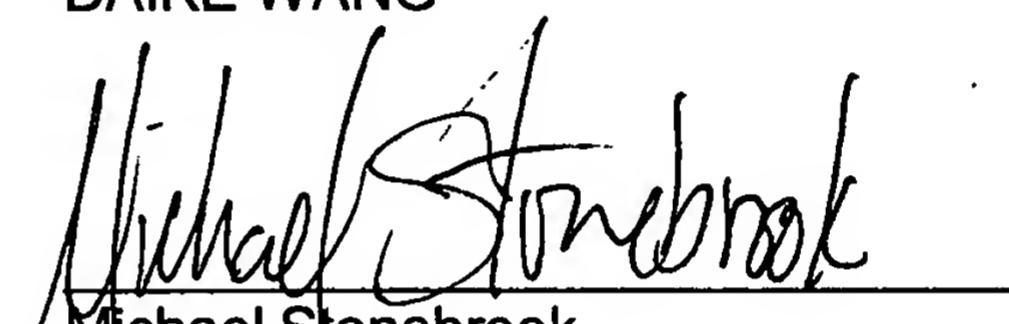
Telephone inquiry to the undersigned in order to clarify or otherwise expedite prosecution of the subject application is respectfully encouraged.

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Date: 2-23-04

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